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# Supreme Court of the United States

**October Term, 1935.**

**No. 388.**

A. G. TRIPLETT, R. M. TRIPLETT, A. NELSON, C. M. TRIPLETT, JR., and THE BALTIMORE GASLIGHT COMPANY,
*Defendants-Petitioners,*

*vs.*

PERCIVAL D. LOWELL, FRANCIS W. DUNMORE, and DUBILIER CONDENSER CORPORATION,
*Plaintiffs-Respondents.*

## PETITION FOR REHEARING.

SAMUEL E. DARBY, JR.,
*Counsel for Petitioners.*

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## PETITION FOR REHEARING.

*To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:*

This cause was argued on March 4th and 5th, 1936, and decided March 30th, 1936 (80 L. Ed., p. 594).

As stated in the opinion of the Court, certiorari was granted in the cause to resolve questions as to the scope and effect of the disclaimer statutes raised in a suit brought to enjoin infringement of several patent claims, some of which had previously been held invalid in an infringement suit in another Circuit against different defendants.

A rehearing of the case is respectfully requested for the following reasons:

1. The Court did not decide a question raised by the petition for writ of certiorari, and presented both orally

and in petitioners' brief. To the contrary, the Court stated in its opinion:

> "We did not decide whether the purported disclaimers operate to enlarge the claims in such fashion as to render both the old and the new claims invalid by virtue of the reissue statute. (See Altoona Publix Theatres vs. American Tri-Ergon Corp, supra, 294 U. S. 490-492; 79 L. Ed. 1003-1015; 55 S. Ct. 455) That question is not presented by the petition for certiorari. The Courts below do not appear to have passed upon it and it may be unnecessary to decide it on the new trial."

We believe that in making the foregoing statement and not deciding this question, which was dispositive of the instant case and if decided favorably to petitioners' contention would have eliminated the necessity of a long, expensive, technical trial on the merits, the Court overlooked the second ground urged for the granting of the petition (see petition for writ of certiorari, pp. 5 and 6) and the argument based thereon in the brief (pp. 13 and 14) which was expressly directed to that point, and the decision of this Court in *Altoona Publix Theatres* v. *American Tri-Ergon Corp.* was quoted from in support thereof.

2. Under the decision of the Court rendered in the present case it is apparently the opinion of the Court that when certain claims of a patent have been held invalid in one suit it is not necessary that a second suit should be brought within a reasonable time, but may be brought at any time before the patent expires. Inasmuch as there are ten Circuit Courts of Appeals it would thereby be possible for a patentee, some of the claims of whose patent have been held invalid in one Circuit, to proceed in all of the remaining Circuits before a time would be reached when his claims would have been finally invalidated. This con-

clusion is in such apparent conflict, in this respect, with the earlier decision of this Court in *Ensten* v. *Simon Ascher & Co.*, 282 U. S. 455, that because of the fact that the earlier decision in the *Ensten* case is referred to in the present opinion as presenting "a different question" it is believed that the Court may have overlooked that in practical effect its decision in the present case overrules its prior decision in *Ensten* case.

Thus, in the *Ensten* case the purpose and intent of the disclaimer statute was fully discussed, and it was therein pointed out that it was *the interest of the public* that prompted the conclusion that—

> "when a competent Court has declared his (the patentee's) pretentions without sufficient foundation, *we think good faith and the spirit of the enactment demand that he act with such promptness as the circumstances permit* either to vindicate his position or *relieve the public from further evil effects of his false assertion*".

Under the decision of the Court in the case at bar, obviously it is left entirely to the election of the patentee as to when, if ever, the public may be relieved "from further ill effects" of the patentee's "false assertion".

It is believed, in the absence of express statement to that effect in the present opinion of the Court, and further, because of the fact that the Court refers to its prior decision in the *Ensten* case as presenting "a different question" it was not the intention of the Court to overrule its prior decision. The result of the present opinion, however, as is apparent from its study, does overrule the prior decision in practical effect.

In view of the extent to which the opinion of this Court in the *Ensten* case has been applied and followed in patent

infringement cases it will be apparent that extensive confusion will result in pending and future patent suits if the situation is not clarified.

## Conclusion.

For the foregoing reasons, therefore, it is earnestly urged that a rehearing be granted in this cause for the purpose of clarifying the scope and application of the disclaimer statutes on pending and future litigations.

Respectfully submitted,

SAMUEL E. DARBY, JR.,
*Counsel for Petitioners.*

New York, N. Y., April 20, 1936.

## Certification.

I hereby certify that the foregoing petition is presented in good faith and not for delay.

SAMUEL E. DARBY, JR.